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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,741	01/30/2004	Ryan C. Lakin	5490-000250/CPB	6558
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HARNESS, DICKEY & PIERCE, P.L.C.				
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BLOOMFIELD HILLS, MI 48303				
EXAMINER				
LEWIS, RALPH A				
ART UNIT		PAPER NUMBER		
3732				
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05/29/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/769,741

Applicant(s)

LAKIN ET AL.

Examiner

Ralph A. Lewis

Art Unit

3732

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-37 and 44-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-37 and 44-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Rejections based on 35 U.S.C. 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4-26 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 22 fail to reasonably set forth a device having minimal structure necessary for acting as an acetabular prosthetic. More particularly, in claim 1, in line 2, it is unclear on what element the claimed "bone engagement surface" is located. It is unclear to this examiner how one can claim a surface without reasonably setting forth some element on which the surface is located. In line 3, it is unclear on what element the "bearing surface" is located or what the "bearing surface" is integral to. Claim 1 is incomplete for omitting essential structural elements and cooperative relationships between the elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

Additionally in claim 1, line 5, it is unclear what constitutes the first prosthetic implant. Moreover, it is unclear if applicant is claiming the "second prosthetic implant" as part of the "acetabular prosthetic" or just that the "acetabular prosthetic" is to be used with a "second prosthetic implant." The scope of the claims must be reasonably clear.

Rejections based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 9, 10, 12-15, 17, 19, 21-23, 25, 27, 28, 30, 34, 35 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Haboush (US 3,067,740).

In Figure 5, Haboush discloses a prosthesis 36 having an outer bone engagement surface 45, inner spherical concave bearing surface 37 for directly engaging the articulating surface 32 of femoral component 10 and locking mechanism 40 for coupling a "second implant" 38 having a spherical concave bearing surface 39 to member 36 so as to surround head 32 of the femoral implant and hold it in position.

It is noted with regard to the "polished" limitation regarding the inner spherical concave bearing surface it is deemed that surface 37 reasonably meets the limitation.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 9, 10, 12-15, 17, 19, 21-25, 27, 28, 30, 32-37 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haboush (US 3,067,740).

To the extent that Haboush fails to explicitly teach that bearing surface 37 of the implant is polished, then one of ordinary skill in the art would have found it obvious to have polished the surface so as to reduce wear between the bearing surface 37 and the surface 32 of the femoral implant. In regard to claim 24, having a plurality of femoral implants on hand so as to treat more than one patient would have been obvious to the ordinarily skilled artisan. In regard to claims 32 and 33, to have checked the fit of the femoral prosthesis in the implant before fastening it together would have been obvious to one of ordinary skill in the art as a matter of routine.

Claims 5-8, 11, 16, 18, 20, 26, 29, 31 and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haboush (US 3,067,740) in view of Frederick et al (US 6,916,342).

Frederick teaches the use of a metallic retaining ring 38 ("second implant") for holding the spherical femoral member 32 in place rather than the claimed polymer retaining members, however, are conventional in the art as evidenced for example by Frederick et al at element 110. To have merely constructed the retaining ring 38 of a polymer instead of metal as is known in the art would have been obvious to the ordinarily skilled artisan. In regard to the limitations requiring the locking member to be a ring structure rather than screws 40 as disclosed by Haboush, Frederick et al teaches that such ring locking members are conventional in the art (e.g. elements 62, 64). To

have merely sued prior art rings to secure the retaining ring 38 in position as is convention in the prior art as evidenced by Frederick et al would have been obvious to one of ordinary skill in the art.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

This application has been transferred since Examiners Stokes and Werner are no longer with the Office. Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Cris Rodriguez, can be reached at (571) 272-4964.

R.Lewis
May 26, 2009

/Ralph A. Lewis/

Primary Examiner, Art Unit 3732